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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,219	01/25/1999	DOUGLAS T. ROSENOFF	962.002US1	9491

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

19

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/237,219	Applicant(s) ROSENOFF ET AL.	
	Examiner Maikhanh Nguyen	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 14, 15, 17 and 19-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14, 15, 17 and 19-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment C filed 01/21/2003 to the application filed 01/25/1999.
2. Claims 1-9, 14-15, 17 and 19-61 are currently pending in this application. Claims 50-61 have been added; claims 1-5, 14-15, 17, 21, 23, 29-30, and 41 have been amended by Applicant. Claims 1- 6, 14, 17, 21, 23, 50 and 61 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 50- 53 and 55-61 are rejected under 35 U.S.C. 102(b) as being anticipated by **Sotomayor** (U.S. 5,943,496 – filed 05/1995).

As to independent claim 50, Sotomayor teaches a method comprising:

- automatically marking one or more portions of the document (automatically identifying significant key topics, concepts, and phrases in the documents; abstract / automatically identifies key topics and phrases in a document's text; col.4, lines 11-21); and

- generating one or more hyperlinks, with each hyperlink associated with at least one of the marked portions and each hyperlink having URL that includes at least a portion of one of the marked portions (embeds hyperlinks...hyperlinks to places in the selected documents... automatically generated hyperlinks; col.4, lines 22-48).

As to dependent claim 51, Sotomayor teaches (col.4, lines 11-48) automatically marking (automatically identifying) one or more portions of a document comprising marking one or more citations to other documents in the document (significant key topics, concepts, and phrases in the documents); and each hyperlink associated with a marked citation has a URL that includes at least a portion of the marked citation (hyperlinks to places in the selected documents).

As to dependent claim 52, Sotomayor teaches one or more of the citations includes a page identifier and a publication identifier (indexed and/or hyperlinked view; col.25, lines 48-57).

As to dependent claim 53, “automatically marking one or more portion of a document comprising proper names in the document” is inherent to the system of Sotomayor.

As to dependent claim 55, Sotomayor teaches the URL for at least one of the hyperlinks includes at least one query connector (the viewer with an indexed and/or hyperlinked view... search for text strings ...having hyperlinks between the index and key topics and/or between key topics as marked in the text of the document; col.35, lines 48-57).

As to dependent claim 56, Sotomayor teaches the URL for at least one of the hyperlinks identifies one of a nature-language search method and boolean search method (search for text strings ...having hyperlinks between the index and key topics and/or between key topics as marked in the text of the document; col.35, lines 48-57).

As to dependent claim 57, Sotomayor teaches the URL for at least one of the hyperlinks includes account information for a user (www.myserver.com/user1; col.11, lines 9-18).

As to dependent claim 58, Sotomayor teaches the URL for at least one of the hyperlinks includes information regarding a third-party sponsor for facilitating access to a document in a database associated with the one hyperlink (a viewer viewing documents... a database provider may make available on the network; col.5, lines 53-67).

As to dependent claim 59, Sotomayor teaches the URL does not identify a logical name for a document in a database to access the documents that a database provider may make available on the network (col.6, lines 31-56).

As to dependent claim 60 is directed to a machine-readable medium comprising instructions for implementing the method of claim 50, and is similarly rejected under the same rationale.

Independent claim 61 is directed to an apparatus for performing the method of claim 50, and is similarly rejected under the same rationale.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 14-15, 17, 19-49 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sotomayor** in view of **Rodkin et al.** (U.S. 6,092,074 – filed 02/1998).

As to dependent claim 54, Sotomayor is silent on “identifies a computerized service for use in conducting a search based on the included portion.”

Rodkin teaches identifying a computerized service for use in conducting a search based on the included portion (querying means...to obtain the at least one destination address corresponding to the matching linkable character string; col.4, lines 55-59).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Rodkin with Sotomayor because it would have provided the capability for allowing a Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

As to independent claim 6, the rejection of claim 50 above is incorporated herein in full. However, claim 6 further recites identifying a computerized service for use in conducting a search based on the included portion.

Sotomayor is silent on “identifying a computerized service for use in conducting a search based on the included portion.”

Rodkin teaches identifying a computerized service for use in conducting a search based on the included portion (querying means...to obtain the at least one destination address corresponding to the matching linkable character string; col.4, lines 55-59).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Rodkin with Sotomayor because it would have

provided the capability for allowing a Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

As to dependent claim 7, Sotomayor teaches each hyperlink further includes account information for a user (www.myserver.com/user1; col.11, lines 9-18).

As to dependent claim 8, Sotomayor teaches each hyperlink includes a domain name common to all the hyperlinks (www.myserver.com; col.11, lines 9-18).

As to dependent claim 9, Sotomayor teaches each hyperlink includes a domain name common to all the hyperlinks and information based on a syntactic or semantic analysis of at least a portion of one of the marked portions of the document (key-topic entries are key concepts and associated hyperlinks that were automatically generated from source documents... identify particularly high semantic weight key words; col.14, lines 52-59).

Independent claim 2, the rejection of independent claim 6 above, is incorporated herein in full. Claim 2, however, further recites:

- receiving one or more documents;
- a step for searching one or more documents for content having one or more predefined forms, with the one or more predefined forms defined prior to receiving the one or more documents; and
- automatically inserting hyperlinks into a document.

Sotomayor teaches:

- receiving one or more documents (scanning one or more documents; abstract);
- a step for searching one or more documents for content having one or more predefined forms with the one or more predefined forms defined prior to receiving the one or more

documents (automatically identifies significant key topics within the selected documents; col.4, lines 24-35); and

- automatically inserting hyperlinks into a document (hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45).

Independent claim 1, includes the same subject matter as in claim 2, and is similarly rejected under the same rationale.

As to dependent claim 19, Sotomayor teaches the one or more predefined forms includes citations to printed publication (At run time...The citation token, if chosen, will be replaced by the filename of the output document 64; col.28, lines 14-17).

As to dependent claim 20, Sotomayor teaches one or more of the marked portions includes a citation to a document, the citation including a volume identifier, a page identifier, and publication identifier, and wherein at least one of the generated hyperlinks includes volume, page, and publication identifiers (automatically identifying significant key topics, concepts, and phrases in the documents; abstract).

As to dependent claim 22, Sotomayor teaches one or more of the generated hyperlinks further includes at least one search instruction (search for text strings...between key topics as marked in the text of the document; col.35, lines 48-57).

Dependent claim 25 includes the same subject matter as in claim 2, and is similarly rejected under the same rationale.

As to dependent claim 26, Sotomayor teaches one or more of the generated hyperlinks further includes information identifying a third-party sponsor for facilitating access to a document in a database associated with the one hyperlink (identified by HTML heading tokens; col.14, lines 31-51).

As to dependent claim 27, Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions (inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45).

As to dependent claim 28, Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions includes associating at least one of the generated hyperlinks with at least two of the marked portions (inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45).

Independent claim 3 is directed to a computer system for performing the method of the claim 2, and is similarly rejected under the same rationale.

Independent claim 4 is directed to a computer system for performing the method of the claim 2, and is similarly rejected under the same rationale.

However, claim 4 further recites “a processor” and “a memory.”

Sotomayor teaches a processor (a web browser; col.5, line 53) and a memory (memory; col.5, line 64).

Independent claim 5 is directed to a computer-readable medium for implementing the method of claim 2, and is similarly rejected under the same rationale.

As to independent claim 14, the rejection of claim 50 above is incorporated herein in full. However, claim 14 further recites “defining a hyperlink to point to one of at least two or more destinations based on one or more user preferences.”

Sotomayor is silent on “defining a hyperlink to point to one of at least two or more destinations based on one or more user preferences.”

Rodkin teaches defining a hyperlink to point to one of at least two or more destinations based on one or more user preferences (filtering destination addresses...according to preference criteria... assigned linkable character strings; col.10, lines 12-16).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Rodkin with Sotomayor because it would have provided the capability for allowing a Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

As to dependent claim 15, Sotomayor is silent on “one or more user preferences includes information related to one or more preferred hyperlink destinations, or information related to cost, or information related to access time; and wherein defining the hyperlink includes selecting the one destination based on the retrieved preferences.”

Rodkin teaches one or more user preferences includes information related to one or more preferred hyperlink destinations, or information related to cost, or information related to access time; and wherein defining the hyperlink includes selecting the one destination based on the retrieved preferences (Destination preferences 568 may influence the destination decision filter 565 so that preferred addresses are selected. For example, particular destination addresses may be assigned a preferred status upon payment of a fee, or based on other proprietary interest; col.13, line 65-col.14, line 2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Rodkin with Sotomayor because it would have provided the

capability for allowing a Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

As to dependent claim 29, Sotomayor is silent on “the one or more user preferences includes information related to cost; and wherein defining the hyperlinks including selecting the one destination based on cost.”

Rodkin teaches the one or more user preferences includes information related to cost; and wherein defining the hyperlinks including selecting the one destination based on cost (Destination preferences 568... destination addresses may be assigned a preferred status upon payment of a fee, or based on other proprietary interest; col.13, line 65-col.14, line 2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Rodkin with Sotomayor because it would have provided the capability for allowing a Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

As to dependent claim 30, Sotomayor is silent on “the one or more user preferences includes information related to access time; and defining the hyperlinks including selecting the one destination based on access time.”

Rodkin teaches the one or more user preferences includes information related to access time; and defining the hyperlinks including selecting the one destination based on access time (The preference criteria may designate a particular type of web site... which the candidate destination addresses are obtained; col.12, lines 18-28).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Rodkin with Sotomayor because it would have

provided the capability for allowing a Web developer to automatically enter hypertext links into a computer file such as a news article or other sequence of user-readable character strings.

As to dependent claim 31, Sotomayor teaches one of two or more destination is within the computer system and another of the two or more destinations is without the computer system (hyperlink destinations; col.9, lines 11-45).

Dependent claim 32- 35 include the limitations as in claims 20-22 and 47, and are similarly rejected under the same rationale.

Dependent claims 36- 38 include the limitations as in claims 25-26 and 28, and are similarly rejected under the same rationale.

Independent claim 17, includes the same subject matter as in claim 2, and is similarly rejected under the same rationale.

As to dependent claim 39, Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions (inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45).

As to dependent claim 40, Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions includes associating at least of the generated hyperlinks with at least two of the marked portions (inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45).

As to dependent claim 41, Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions includes anchoring at least one of the

generated hyperlinks to at least one of the marked portions (inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45).

As to dependent claim 42, Sotomayor teaches searching the one or more documents comprises searching for citations to other publication (At run time... The citation token, if chosen, will be replaced by the filename of the output document 64; col.28, lines 14-17).

As to dependent claim 43 includes the same limitations as in claim 42, and is similarly rejected under the same rationale.

As to dependent claim 44, “ searching the one or more documents comprises searching for proper names” is inherent to the system of Sotomayor.

Dependent claims 45 and 46 include the limitations as in claims 32 and 21, and are similarly rejected under the same rationale.

Dependent claim 47 includes the same limitations as in claim 35, and is similarly rejected under the same rationale.

Dependent claims 48-49 include the same limitations as in claims 25-26, and are similarly rejected under the same rationale.

Independent claim 21, the rejection of claim 2 above is incorporated herein in full. However, claim 21 further recites one or more of the generated hyperlinks includes at least one query connector

Sotomayor teaches one or more of the generated hyperlinks includes at least one query connector (the viewer with an indexed and/or hyperlinked view... search for text strings

...having hyperlinks between the index and key topics and/or between key topics as marked in the text of the document; col.35, lines 48-57).

Independent claim 23, the rejection of claim 2 above is incorporated herein in full. However, claim 23 further recites one or more of the generated hyperlinks further includes a search-method identifier.

Sotomayor teaches one or more of the generated hyperlinks further includes a search-method identifier (automatically identifies significant key topics within the selected documents; abstract).

As to dependent claim 24, Sotomayor teaches the search-method identifier identifies one of a natural-language search method and a Boolean search method (search for text strings...between key topics as marked in the text of the document; col.35, lines 48-57).

Response to Arguments

5. Applicant's arguments filed 01/21/2003 have been fully considered but are moot in view of the new ground(s) rejection.

Applicant argues that "*claims 1-9, 17, 19, and 39-49 have been amended...it does not appear that one of skill would regard Sotomayor as meeting all the requirement of claims 1-9, 17, 19, 22, 25-28, and 39-49.*" (Remarks; pages 8-9)

Examiner agrees. However, the amended claims are met by the combination of Sotomayor and Rodkin as clarified in the rejection above.

Applicant argues that "*claims 14, 21, 23, and 46-49...these amended claims are still believed to distinguish from Sotomayor based on the remaining requirements related to 'user preferences.'*" (Remarks; page 9)

Examiner agrees. However, the amended claims are met by the combination of Sotomayor and Rodkin as clarified in the rejection above.

Applicant argues that "*new claims 50-61 are believed to distinguish from Sotomayor ...nothing in Sotomayor appears to meet this requirement.*" (Remarks; page 9)

Examiner disagrees. The rejection above shows that Sotomayor meets the limitations of claims 50-61 as broadly claimed in the application.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sherman et al. U.S Patent No. 6,233,591 issued dated: May 15, 2001

Straub et al. U.S Patent No. 6,216,141 issued dated: Apr. 10, 2001

7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 8:30am – 6:00 pm. The Examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Contact Information:

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.

OFFICIAL faxes must be signed and sent to (703) 746-7239.

NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday,

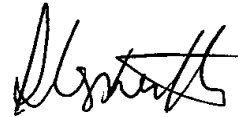
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Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen

April 4, 2003

A handwritten signature in black ink, appearing to read 'Stephen S. Hong', with a stylized, cursive script.

STEPHEN S. HONG
PRIMARY EXAMINER